REMARKS

Independent claims 28 and 40 and the claims dependent thereon have been amended, as appropriate, to incorporate the terminology "user entity" which paragraph 0055 of the specification, as published, indicates means actions/events involving only the mobile device and action/events involving the user acting through the mobile device. Claim 28 has also been amended to indicate the service provider system differs from the party that qualified the user entity. Claim 40 has been amended to indicate the qualifying-party indicator is indicative of a party for providing the qualifying-party indicator to the qualification subsystem and to indicate the service delivery subsystem differs from the party for providing the qualifying-party indicator to the qualification subsystem. Claim 44 indicates the qualifying subsystem is included in the mobile entity. The foregoing changes are supported by applicants' published specification in paragraphs 0073-0076.

New claims 45 and 46, respectively dependent on claims 1 and 18, require the user associated program instance to include instructions advising the user to perform an act associated with the purchased service or product, wherein the act is in addition to and differs from the purchased service or product. New claim 47, dependent on claim 28, requires the user associated program instance to include instructions advising the user to perform an act associated with the purchased service or product, wherein the act is in addition to and different from the purchased service or product. New claim 48 is similar to claim 47, but depends on claim 40, and indicates the service delivery subsystem renders the secondary service at a time and/or place different from rendering of the primary service.

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Paragraph 0063 of the application as published provides support for these limitations, which are not made obvious by the art of record.

The foregoing changes to claims 28 and 40 are not disclosed by the art previously applied against these claims, that is, applicants' admitted prior art, in combination with Valentine et al., US Patent 6,011,973, and Tarbox, US Patent 5,705,798. The admitted prior art includes no information concerning the contents of the authorization token, other than that the identification of the mobile entity might be embedded in the token. Valentine et al. does not specifically mention a service token, and does not indicate that the service authorization, which the examiner has equivocated to the claimed service token, is from a service provider system different from the party that qualified the user entity, as required by claim 28. The Valentine et al. service authorization cannot be considered as a service delivery subsystem that differs from a party providing a qualify-party indicator to a qualifying subsystem, as required by claim 40. Tarbox also does not appear to be related to a service token and fails to disclose the previously discussed new limitations of claims 28 and 40. Consequently, claims 28 and 40 and the claims dependent thereon are patentable over the prior art previously applied against them.

The inference on page 2, item 3 of the office action that the only argument applicants submitted in the last substantive response of November 23, 2005, related to the words "particular service" is incorrect. Page 13 of that response specifically states the Valentine et al. fails to disclose storing, after a transaction has been conducted, a user-associated instance of an executable program for implementing a particular service a user has purchased, wherein the program instance is customized for the transaction and is distinct from location data indicative of a location where service delivery is to be triggered. Applicants also argued that controlling the operation of a mobile phone by location, as disclosed by Valentine et al., is not in the same technical field, or a related technical field, to electronic transaction cards, as disclosed by Tarbox and that one of ordinary skill in the art would not make an electronic transaction of the type discussed by Tarbox location triggered. Applicants also argued that the "particular service" of claims 1 and 18 is provided as a consequence of an earlier transaction, wherein the service is not itself the

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transaction.   Applicants also noted that at the November 22, 2005, interview, the examiners were unable to identify what, in the proposed combination of Valentine et al. and Tarbox is the "transaction" of claim 1.

For the foregoing reasons, the "Response to Arguments" portion of the office action is inaccurate. The examiner has failed to meet the requirements for a proper rejection under 35 UCS 103(a) because he has not addressed the foregoing arguments set forth by applicants.

The office action, in the last full paragraph on page 4, admits Valentine et al. does not disclose the claim 1 requirement of "conducting a transaction of a user purchasing a service or product." The paragraph bridging pages 4 and 5 of the office action also admits Valentine et al. fails to disclose the claim 1 limitation for "a user-associated instance of executable program, for implementing the particular service, the program instance been customized for said transaction and distinct from the location data" and "initiating execution of the user-associated program instance to deliver the particular service to the user." The office action alleges Tarbox discloses both of these features and that it would have been obvious to one of ordinary skill in the art to have modified Valentine et al. to include these features. The alleged motivation for modifying Valentine et al. with regard to the omission admitted in the last full paragraph on page 4 is "to perform more electronic transaction of product such that a user can make a transaction in a particular area whenever he needs (sic)." The alleged motivation for modifying Valentine et al. with regard to the omission admitted in the paragraph bridging pages 4 and 5 is "to conduct one or more electronic transaction of product such that a user can enjoy making transaction in a particular place he is authorized without having any inconvenience (sic)."

Because Valentine et al. is only interested in restricting the operation of cellular telephones to well delineated geographical areas (see the title and column 1, lines 11 and 12 of Valentine et al.), that is, preventing cell phone communications in a region where the cell phone owner is not authorized to use a cell phone, the alleged motivations have no basis from the Valentine et al. reference. In Valentine et al., the cell phone operating company, that is, the company that wants to limit the operation of cellular telephones to well defined geographical areas, is not interested in making a transaction in a particular

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area. The cell phone user only wants to make a call. In all likelihood, the cell phone user wishes he did not have geographic limitations the cell phone operating company is imposing on him. Since neither the cell phone operating company nor the cell phone user is interested in (1) performing more electronic transactions "of product such that a user can make a transaction in a particular area whenever he needs" or (2) conducting "one or more electronic transaction of product such that a user can enjoy making transactions in a particular place he is authorized without having any inconvenience," the alleged motivations are completely illogical. As result, one of ordinary skill in the art would not have modified Valentine et al. as result of Tarbox. The proposed combination is a classic example of an examiner reading the claims of an applicant and casting about to find disparate references having nothing to do with each other and combining them through the use of hindsight.

The claims dependent on claims 1 and 18 are allowable for the same reasons advanced with regard to claims 1 and 18. In addition, many of these claims are improperly rejected.

The rejection of claim 8, in the last full paragraph on page 5 of the office action, alleges one of ordinary skill in the art would have modified Valentine et al. as a result of Tarbox to provide customization of a generic program for implementing location-triggered service. The alleged motivation for so modifying Valentine et al. is provide a customized display feature to a user. The office action provides no reason why, and applicants are unable to understand why, a user of a cell phone that is restricted to a particular geographic region wants to have a customized display feature.

The rejection of claim 9 appears to incorrectly discuss the limitations of this claim by stating "Valentine teaches that service delivery is conditional upon the user downloading a location information (sic)." In fact, claim 9 requires service delivery to be conditional upon the <u>user</u> inputting a personal identification code. The office action incorrectly alleges this feature is disclosed by Valentine et al. at column 1, lines 54-67 and column 2, lines 1-14, line 45-column 3, line 3. There is no mention whatsoever of a user inputting a personal identification code in this portion of the reference. Column 2 indicates cellular telephone 100 is equipped with memory 150 which can be independent or can be part of a

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Subscriber Identity Module (SIM) card 160. The information contained in memory 150 can either be preprogrammed or can be downloaded from a cellular telephone network via a base station; column 2, line 63-67. There is no indication of the information in memory 150 being responsive to a user of the cellular telephone inputting a personal identification code.

Claim 11 has been amended to indicate service delivery is continued until completion, regardless of the location of the user. This limitation is completely contrary to Valentine et al., wherein service delivery is halted in response to the cell phone moving out of the well delineated geographical area.

Applicants do not understand the paragraph bridging pages 6 and 7 of the office action. This paragraph appears to discuss applicants' claim 14 which depends on claim 1 and requires multiple user-associated program instances associated with different services to be delivered to the same user, and indicates the program instances are stored in a common repository. (Claim 14 has been amended so that the "storing" step is actively, rather than passively defined; this amendment has no effect on the substance of the claim.) The paragraph bridging pages 6 and 7 of the office action, however, refers to a "user-associated program-code instance that is a customization of a generic program for implementing the service." Explanation is in order.

In the rejection of claim 16, the office action alleges Valentine et al. includes a trusted location service provider that inherently digitally signs a current user location. The office action however fails to meet the requirements for a proper rejection based on inherency. A proper rejection based on inherency requires (1) the prior art to necessarily include the alleged inherent feature and (2) rationale and/or evidence must be provided to support the inherency allegation, MPEP Section 2112.

In the rejection of claim 18, the office action states cellular telephone network 170 of Valentine et al. is the qualification subsystem. However, the office action ignores the requirement of claim 18 for the qualification subsystem to conduct a transaction of a user purchasing a service or product that qualifies a user to benefit from a particular location-triggered service. Cellular telephone network 170 of Valentine et al. does not conduct a transaction of a user purchasing a service or product. The office action fails to state a

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reason why one of ordinary skill in the art would have modified the Valentine et al. cellular telephone network 170 to enable such a network to conduct a transaction of a user purchasing a service or product.

The office action also ignores the requirement of claim 18 for the qualification subsystem to create in a service factory (which the examiner equivocates to base station 180 of Valentine et al.) a user-associated instance of executable program for implementing the particular location-triggered service. Valentine et al. states base station 180 provides services for cell phone 100. There is no disclosure of a user-associated instance of an executable program for implementing a particular location-triggered service being created in base station 180. The office action fails to state a reason why one of ordinary skill in the art would have modified base station 180 so it could create a user-associated instance of an executable program for implementing a particular service.

Tarbox fails to include any structures which are similar to (1) a cellular telephone network for conducting a transaction of a user purchasing a service or product or (2) a base station that has created in it a user-associated instance of an executable program for implementing a particular location-triggered service. Therefore, one of ordinary skill in the art would not have modified the Valentine et al. cellular telephone network or the Valentine base station as a result of the Tarbox reference, to meet the limitations of claim 18. Based on the foregoing, the office action fails to establish a prima facie case of obviousness with regard to claim 18.

The rejections of claims 23 and 24 equivocate the Valentine et al. location information to the requirement in these claims for a program instance. However, claim 1, upon which claims 23 and 24 depend, indicates the program instance is distinct from the location data. Consequently, the rejection of claims 23 and 24 ignores a requirement of these claims.

The rejection of claim 25 equivocates the Valentine et al. "location updating" to the claimed user-associated instance of an executable program for implementing a particular location-triggered service which is stored in a service provider system that the examiner apparently interprets as the cellular telephone network 170 of Valentine et al.: The "location updating" is performed in cellular telephone 100 in response to instructions from

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base station 180. However, claim 25 requires the program instance to be executed by the service provider system. Because the Valentine et al. service provider system and cellular telephone 100 are not the same, Valentine et al. does not disclose the requirements of claim 25 and the rejection is wrong.

The rejection of claim 7, based on Valentine et al. in view of Tarbox, further in view of Eldridge et al., US patent 6,601,102, is incomprehensible. This rejection states Valentine et al. discloses in its abstract; Figure 3; page 4, lines 14-20, and page 10, lines 6-14, 23 and 24 a user-assisted program instance including user identity data that is digitally-signed by a party that carried out a qualification step. However, neither the Valentine et al. abstract nor Figure 3 of Valentine mentions anything about digital signing. Further, Valentine et al. does not include a page 4 or a page 10. Explanation is in order.

The rejections of claims 7 and 15 state one of ordinary skill in the art would have been motivated to have modified Valentine et al., as a result of Eldridge in order to perform secure token-based document transaction services using a key pair. However, Valentine et al. is concerned with restricting operation of cellular telephones to well delineated geographical areas and is not at all concerned with token-based document transactions services, no less such services using a key pair. Consequently, one of ordinary skill in the art would not have modified the examiner's proposed combination of Valentine et al. and Tarbox as a result of Eldridge.

Claim 33, dependent on claim 28, is rejected for the same reasons as discussed with respect to claim 9. Applicants have previously indicated why the rejection of claim 9 is wrong.

In view of the foregoing amendments and remarks, allowance is in order.

Application No.: 09/881,040   Docket No.: 30003033-2 (1509-188)

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 08-2025 and please credit any excess fees to such deposit account.

Respectfully submitted,

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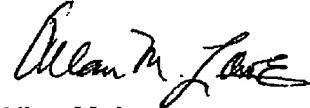
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